

REMARKS

Claims 1-7, 10-20, 38-49, and 57-60 are currently pending in the subject application and are presently under consideration. Claims 1, 2, 4, 6, 12, 16, 18, 38-40, 42, 46-48, and 59-60 have been amended, and claims 20, 43, and 49 have been cancelled, as shown on pp. 2-9 of the Reply. The amendments to the claims are fully supported by the originally filed application. With respect to independent claims 1, 38, 46, and 60, see for example the originally filed application at pages 9-12 and 24-25. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-7, 10-19 and 57-59 Under 35 U.S.C. §101

Claims 1-7, 10-19 and 57-59 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants' representative has amended independent claim 1 and respectfully submits that claim 1 clearly recites statutory subject matter within the bounds of 35 U.S.C. §101.

Applicants' representative further submits that claims 2-7, 10-19 and 57-59 also clearly recite statutory subject matter within the bounds of 35 U.S.C. §101. Namely, because claims 2-7, 10-19 and 57-59 depend from independent claim 1, Applicants' representative respectfully submits that claims 2-7, 10-19 and 57-59 are statutory for at least the same reasons as claim 1.

Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claim 60 Under 35 U.S.C §112

Claim 60 stands rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 60 has been amended to further clarify the language cited by the Examiner. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 1, 5, 10-19, 38-40, 42, 43, 46-49, and 57-60 Under 35 U.S.C. §103(a)

Claims 1, 5, 10-19, 38-40, 42, 43, 46-49, and 57-60 stand rejected under 35 U.S.C. §103(a) as being allegedly anticipated by U.S. Patent No. 6,438,533 to Spackman, *et al.* (hereinafter "Spackman") in view of U.S. Patent No. 5,924,074 to Evans (hereinafter "Evans").

With respect to Spackman, Applicants' representative respectfully points out that, although Spackman claims priority to a provisional application (U.S. Provisional Patent Application Serial No. 60/106,465, hereinafter "Provisional Spackman") filed before the effective filing date of the subject application, the filing date of the non-provisional conversion cited by the Examiner is **later** than the effective filing date of the subject application. Specifically, the effective filing date of the subject application is June 18, 1999 (since the subject application claims the benefit of U.S. Provisional Application No. 60/140,102, filed June 18, 1999), whereas the filing dates of Spackman and Provisional Spackman are October 29, 1999 and October 30, 1998, respectively. Accordingly, Applicants' representative respectfully submits that only subject matter disclosed in Provisional Spackman is prior art to the subject application.

It is respectfully submitted that Provisional Spackman either alone or in combination with Evans does not obviate every aspect of the rejected claims. In particular, this rejection should be withdrawn for at least the following reasons.

Rejected claims 1, 5, 10-19, 38-40, 42, 43, 46-49, and 57-60 generally encompass methods, systems, and computer-readable storage media for generating a document relating to a patient's medical diagnosis. Without acquiescence to the Examiner's rejection, in the interest of expediting prosecution and further clarifying the claimed subject matter, each of independent claims 1, 38, 46, and 60 has been amended. As amended, each of claims 1, 38, 46, and 60 encompasses aspects for generating at least one **new** document, which are not disclosed by Provisional Spackman or Evans.

For instance, each of claims 1 and 60 recite *inter alia* "retrieving a list of links to content in [] one or more databases that satisfy [a] search criteria, the retrieved list of links **stored** in a memory component...**pre-selecting** a subset of the links associated with [] at least one matching diagnostic code and [] at least one matching context, the subset of links **automatically** pre-selected from the retrieved list of links **independent of a query provided by a user for the subset of links**...and generating at least one **new** document, wherein **the at least one new document comprises the pre-selected subset of links and at least a portion of [] information received about [a] patient.**"

Provisional Spackman does not disclose at least these novel aspects recited in claims 1 and 60. Provisional Spackman is generally directed towards searching and retrieving patient records using a terminology knowledge base. However, rather than disclosing a "subset of links

automatically pre-selected from [a] retrieved list of links ***independent of a query provided by a user for the subset of links***,” Provisional Spackman simply teaches utilizing the disclosed knowledge base to translate ***user queries*** for patient records, wherein the records are analyzed and retrieved in view of the ***user query*** and conceptual relationships defined in the knowledge base. (See e.g., Provisional Spackman, Page 7, Second Paragraph). Furthermore, although Provisional Spackman teaches that a knowledge base of medical concepts can be maintained to facilitate record retrieval, these teachings are limited to retrieving ***an already existing record*** rather than ***generating a new document***. (See e.g., Provisional Spackman, Page 16, First Paragraph). Provisional Spackman also does not contemplate records which augment the concepts stored in the knowledge base with pre-selected links to external sources of pertinent data. Provisional Spackman thus cannot teach “generating at least one ***new*** document, wherein ***the at least one new document comprises [a] pre-selected subset of links and at least a portion of [] information received about [a] patient***.” Accordingly, Provisional Spackman does not disclose each and every aspect recited in claims 1 and 60.

Evans does not cure the deficiencies of Provisional Spackman. Evans is generally directed towards creating and maintaining patient data electronically. Specifically, Evans discloses an icon-based user interface that enables healthcare providers to capture and analyze patient data at the point of care. (See e.g., Evans, Column 2, lines 28-32). However, rather than disclosing a “subset of links ***automatically*** pre-selected from [a] retrieved list of links ***independent of a query provided by a user for the subset of links***,” Evans simply discloses providing health care providers with access to a reference database, wherein the health care provider is required to ***manually*** enter a plurality of appropriate diagnostic codes. (See e.g., Evans, Column 11, lines 30-64). Indeed, nowhere does Evans even contemplate a “pre-selected subset of links,” as recited in claims 1 and 60. Evans thus cannot further disclose “generating at least one ***new*** document, wherein ***the at least one new document comprises [a] pre-selected subset of links and at least a portion of [] information received about [a] patient***,” as recited in claims 1 and 60. Accordingly, Evans does not cure the deficiencies of Provisional Spackman.

With respect to claim 38, Applicants’ representative further submits that Provisional Spackman either alone or in combination with Evans does not obviate every aspect recited in claim 38. For instance, claim 38 recites *inter alia* a “first database retrieves and ***stores*** a set of links to content in external data sources that satisfies [a] set of queries, each link associated with

[a] diagnostic code and context that facilitated retrieval of the respective link” and “a first server that...*pre-selects* from the first database a subset of the links associated with the at least one matching diagnostic code and related context, wherein the subset of links are *automatically* pre-selected from the stored list of links *independent of a query provided by a user for the subset of links*, the first server generating *at least one new document comprising the pre-selected subset of links and at least a portion of [] information about [a] patient.*” Here, rather than disclosing a “subset of links [] *automatically* pre-selected from [a] stored list of links *independent of a query provided by a user for the subset of links*,” or disclosing “generating *at least one new document comprising the pre-selected subset of links and at least a portion of [] information about [a] patient*,” Provisional Spackman again only teaches translating *user queries* to retrieve *already existing* patient records (*See e.g.*, Provisional Spackman, Page 7, Second Paragraph & Page 16, First Paragraph), whereas Evans again only teaches access to a reference database that requires diagnostic codes to be *manually* entered (*See e.g.*, Evans, Column 11, lines 30-64). Accordingly, Provisional Spackman either alone or in combination with Evans does not obviate every aspect recited in claim 38.

Applicants’ representative further submits that Provisional Spackman either alone or in combination with Evans does not obviate every aspect recited in claim 46. For instance, claim 46 recites *inter alia* “retrieving and *storing* a list of data source links from one or more external data sources that satisfy [a] search criteria ...performing a query function to *pre-select* from a database a subset of the data source links associated with a stored diagnostic code and at least one or more stored contexts matching [a] received information about [a] patient, the subset of data source links *automatically pre-selected from the stored list of data source links independent of a query provided by a user for the subset of data source links*...and generating *at least one new document comprising the subset of data source links pre-selected from the database.*”

However, as stated previously with respect to each of claims 1, 38, and 60, Provisional Spackman simply teaches translating *user queries* to retrieve *already existing* patient records (*See e.g.*, Provisional Spackman, Page 7, Second Paragraph & Page 16, First Paragraph), whereas Evans simply teaches access to a reference database that requires diagnostic codes to be *manually* entered (*See e.g.*, Evans, Column 11, lines 30-64). Accordingly, neither Provisional Spackman nor Evans disclose a “subset of data source links *automatically pre-selected from [a] stored list of data source links independent of a query provided by a user for the subset of data*

*source links,” or “generating **at least one new document comprising the subset of data source links pre-selected from [a] database,**” as recited in claim 46.*

In view of at least the above, it is respectfully submitted that Provisional Spackman either alone or in combination with Evans does not obviate every limitation of Applicants’ invention as recited in independent claims 1, 38, 46, and 60.

Applicants’ representative further submits that Provisional Spackman either alone or in combination with Evans does not obviate Applicants’ invention as recited in dependent claims 5, 10-19, 39-40, 42, 47-48, and 57-59. Namely, because claims 5, 10-19, 39-40, 42, 47-48, and 57-59 respectively depend from independent claims 1, 38, and 46, Applicants’ representative submits that claims 5, 10-19, 39-40, 42, 47-48, and 57-59 are allowable for at least the same reasons as claims 1, 38, and 46.

Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 6, 7, 41, 44 and 45 Under 35 U.S.C. §103(a)

Claims 6, 7, 41, 44 and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Spackman, *et al.* (US 6,438,533) in view of Evans (US 5,924,074) and in view of Kirk, *et al.*(US 5,768,578). It is respectfully submitted that Kirk fails to overcome the deficiencies of Provisional Spackman and Evans, which are noted above with respect to the rejection of claims 1 and 38 under 35 U.S.C. §103(a). Dependent claims 6, 7, 41, 44 and 45 depend from allowable claims 1 and 38, and are therefore likewise allowable for at least the same reasons.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt allowance is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP1909USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,
TUROC & WATSON, LLP

/Daniel Castro/
Daniel Castro
Reg. No. 60,359

TUROC & WATSON, LLP
57th Floor, Key Tower
127 Public Square
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731